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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,471	10/31/2003	John M. Murphy	31849.39	2768
27683	7590	07/11/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			NEAL, TIMOTHY J	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,471

Applicant(s)

MURPHY ET AL.

Examiner

Timothy J. Neal

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/28/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 28 referring to "snap ring" (P5 L18). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "one of the surfaces" in line 1 of the claim. The use of the term "one of the surfaces" makes the claim indefinite because the Examiner cannot precisely determine which element "one of the surfaces" refers to. In claim 2, surfaces for both the blade and the actuator are presented. Further specification of which one of the surfaces the claim refers to is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-19, 21, and 23-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (U.S. 2,091,628).

Regarding **claim 1**, Carlson discloses a housing (Fig. 1 Item 14) having a bore (Fig. 1 Item 14) and at least one-slot formed through its wall (Fig. 3 Item 24), a cutting blade extending through the slot (Fig. 3 Item 26), and an actuator disposed in the bore and in engagement with the blade so that axial movement of the actuator in the bore causes radial movement of the blade relative to the slot (Fig. 1 Item 28).

Regarding **claim 2**, at least one surface on the actuator engages a corresponding surface on the blade to cause the radial movement in response to the axial movement (Fig. 3 Item 26 and Item 28).

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Regarding **claim 3**, wherein one of the surfaces is a tapered surface (Fig. 1 Item 50).

Regarding **claim 4**, wherein the surface on the actuator is a conical surface and the surface on the blade is a tapered surface (Fig. 1 Item 26 and Item 50).

Regarding **claim 5**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots (Fig. 5 Item 14b).

Regarding **claim 6**, wherein one surface on the actuator engages a corresponding surface on all of the blades (Fig. 3).

Regarding **claim 8**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots (Fig. 5 Item 14b).

Regarding **claim 10**, a biasing member for biasing the blade radially inwardly relative to the housing (Fig. 1 Item 30).

Regarding **claim 11**, wherein the biasing member is a garter spring (Fig. 3 Item 30).

Regarding **claim 12**, an adjustment member engaging the actuator and adapted to be manually actuated for causing the axial movement of the actuator (Fig. 1 Item 56).

Regarding **claim 13**, where in the adjustment member is a bolt in threaded engagement with the actuator (Fig. 1 Item 56).

Regarding **claim 14**, wherein the radial movement of the blade changes the amount of cutting by the tool (Page 1 Col 1 Lines 17-21).

Regarding **claim 15**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots so that the cutting pattern is circular (Fig. 5 Item 14b).

Regarding **claim 16**, a method comprising extending at least one cutting blade through a slot formed in a tubular housing, and moving an actuator member axially in the housing so that engaging surfaces on the blade and the member causes corresponding radial movement of the blade relative to the slot to adjust the amount of cutting (Page 2 Column 1 Lines 17-25).

Regarding **claim 17**, further comprising forming at least one surface on the actuator that engages a corresponding surface on the blade to cause the radial movement in response to the axial movement (Fig. 3 and Page 2 Column 1 Lines 17-25).

Regarding **claim 18**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots (Fig. 5 Item 14b).

Regarding **claim 19**, further comprising engaging all of the surfaces of the blades by the surface of the actuator (Fig. 3).

Regarding **claim 21**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots (Fig. 5 Item 14b).

Regarding **claim 23**, further comprising biasing the blade radially inwardly relative to the housing (Fig. 3 Item 30).

Regarding **claim 24**, further comprising manually actuating an adjustment member on the housing for moving the actuator (Fig. 1 Item 56).

Regarding **claim 25**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots so that the cutting pattern is circular (Fig. 3).

Regarding **claim 26**, a housing having a bore and at least one slot formed through its wall, a cutting blade extending through the slot, and means for moving the blade radially relative to the slot to change the amount of cutting (Fig. 3 and Page 2 Col 1 Lines 17-25).

Regarding **claim 27**, wherein the means is disposed in the bore in engagement with the blade so that axial movement of the means in the bore causes radial movement of the blade relative to the slot (Page 2 Column 1 Lines 17-25).

Regarding **claim 28**, wherein at least one surface on the means engages a corresponding surface on the blade to cause the radial movement (Fig. 3).

Regarding **claim 29**, wherein the surface on the means is a conical surface and the surface on the blade is a tapered surface (Fig. 1 Item 26 and Item 50).

Regarding **claim 30**, wherein there are a plurality of angularly spaced slots formed through the housing and a corresponding number of blades respectively mounted in the slots (Fig. 3).

Regarding **claim 31**, wherein one surface on the means engages a corresponding surface on all of the blades (Fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson (U.S. 2,091,628). Carlson discloses the invention substantially as claimed as stated above. Carlson does not disclose a plurality of axially-spaced surfaces formed on the actuator and a plurality of axially-spaced surfaces formed on the blade wherein each surface on the actuator engaging a corresponding surface formed on the blade to cause the radial movement in response to the axial movement. Carlson does teach having a plurality of blades axially-spaced along the device (Page 2 Col 1 Lines 68-71). Such teaching would thus include a plurality of axially-spaced surfaces formed on the actuator and a plurality of axially-spaced surfaces formed on the blade wherein each surface on the actuator engaging a corresponding surface formed on the blade to cause the radial movement in response to the axial movement. Therefore, it would have been obvious to someone having ordinary skill in the art at the time the invention was made to modify Carlson's cutting tool to include multiple blades and actuators as taught by Carlson. Such a modification would be in order to ream more than one object at a time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Neal whose telephone number is (571) 272-0625. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJN


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
6/26/05.